

REMARKS

I. CLAIM AMENDMENTS

Applicants amended method some claims to improve their form or correct grammar. The amendments are not made for any reasons related to patentability of the claims, and does not introduce new matter.

II. RESTRICTION REQUIREMENT IS TRAVERSED

In the Office Action, a restriction requirement was issued requesting that Applicants elect one of the following inventions for prosecution under 35 U.S.C. §121:

- I. Claims 1-33 and 68, drawn to an analytical device, classified in class 435, subclass 970.
- II. Claims 34-36, drawn to an appliance, classified in class 422, subclass 63.
- III. Claims 37-67, 69 and 70, drawn to a method for assaying an analyte in a sample, classified in class 435, subclass 7.1.

It was stated that the inventions of Groups I and II are related as combination and subcombination and that such inventions are distinct if it can be shown that:

1. the combination as claimed does not require the particulars of the subcombination as claimed for patentability; and
2. the combination has utility by itself or in other combinations.

MPEP § 806.05 (c) was relied upon for this assertion. It was asserted that in this application, the claimed combination does not require the particulars of the claimed subcombination because Group II does not require the non-immobilized molecule for

patentability and does not require an analyte or analogue in an immobilized state for patentability. It was also asserted that the subcombination has separate utility, for example, in immunological separation processes or sample purification processes.

Additionally, it was asserted that the inventions of Groups I and III are related as product and process of use. Thus, according to the Office Action, under MPEP § 806.05(h) such inventions can be shown to be distinct if either or both of the following can be shown:

1. the process for using the product as claimed can be practiced with another materially different product, or
2. the product as claimed can be used in a materially different process of using that product.

In this case, it was asserted, the claimed product can be used in a materially different process, such as in immunological separation processes or sample purification processes.

Further, inventions of Group II and III were said to be related as process and apparatus for its practice. According to the Office Action, pursuant to MPEP § 806.05(e), such inventions are distinct if it can be shown that:

1. the process as claimed can be practiced by another and materially different apparatus or by hand, or
2. the apparatus as claimed can be used to practice another and materially different process.

In this case, according to the Office Action, the apparatus as claimed can be used to practice another and materially-different process, such as immunological separation processes or sample purification processes. Office Action, pp. 2-3.

It was concluded that since inventions are distinct, as summarized above, and have acquired a separate status in the art as shown by their different classification, the search required for one asserted group of the inventions is not required for other groups; thus the restriction was proper, according to the Office Action. *Id.*, p. 3.

Applicants elect, with traverse, for prosecution Group I.

According to the MPEP, when all claims in the application can be searched and examined together without serious burden, the U.S. Patent and Trademark Office ("PTO") must examine the claims on the merits even though they include claims to independent and distinct inventions. See, the MPEP at 803. In establishing that a "serious burden" would exist for co-examination of claims, the PTO must show with an appropriate explanation one of the following:

- (a) the restricted groups have a separate classification,
- (b) each invention acquired a separate status in the art even though the inventions are classified together; or
- (c) searching would require different fields of search.

See MPEP at §808.02.

In this application, claims of Groups I and II, while patentably distinct from each other, are directed to a similar subject matter insofar as the appliance of Group II includes the multiplicity of devices of Group I. For at least this reason, these inventions should be examined together.

Claims of Groups I and III, while also patentably distinct from each other, are directed to an analytical device and a method for assaying an analyte, respectively. They are also related to each other as underscored by the classification of both of these groups in Class 435, though in different subclasses.

Although claims of Group II are patentably distinct from claims of Group III, they are related at least because the appliance of Group II may be used to conduct the method of Group III.

Furthermore, different classification of claims is not necessarily an indication of the distinctiveness of Group I from Groups II and III. Art relevant to the claims of Group I may be found in the class/subclass associated with Groups II and III and vice versa. Therefore, Applicants respectfully submit that no serious burden will be placed on the U.S. Patent and Trademark Office in examining all the currently pending claims in the application.

In view of the above remarks, it is respectfully requested that the restriction requirement be withdrawn and that all claims be allowed to be prosecuted in the same patent application. In the event that the requirement is made final and in order to comply with 37 C.F.R. § 1.143, Applicants provisionally elect with traverse claims 1-33 and 68 (Group I), holding claims 34-67, 69 and 70 in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

III. Request for Allowance

Applicants respectfully submit that all claims are in condition for allowance, an indication of which is solicited.

In the event any outstanding issues remain, Applicants would appreciate the courtesy of a telephone call to the undersigned Applicants' representative to resolve such issues in an expeditious manner and place the application in condition for allowance.

APPLN. NO.: 10/659,367
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RESPONSE AND AMENDMENT DATED: APRIL 7, 2006

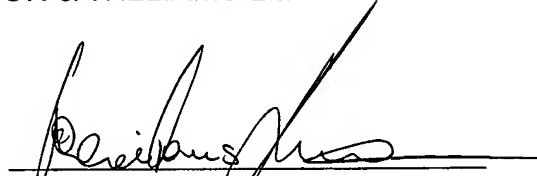
It is believed that no fees are due. However, in the event that any other fees are necessary, the Director is hereby authorized to charge such fees or credit overpayment to our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: April 7, 2006

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